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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 04/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/137,503

Applicant(s)

GRAEF ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,6-26,31-33 and 62-77 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-20,24,25,32,33 and 62-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

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This application has been withdrawn from issue for further prosecution as stated in the letter of 3-19-01. This office action will be a non-final.

Applicant's election of 1-28-02 is noted. Claims 1,6-20,24,25,32,33,62-77 have been examined and claims 21,22,23,26, and 31 are withdrawn as being drawn to a non-elected invention. Claims 21-23,26 are not readable on the invention specified by applicant in the response of 8-27-01.

The petition to accept photographs of 8-2-98 does not appear to have been decided even though the application was passed to issue; therefore the drawings are not acceptable as formals yet. The previous examiner did not have the authority to accept photographs because this must be decided by the Group Director. If this is incorrect and the petition has already been decided the examiner requests applicant's counsel to make the examiner aware of the decision. Applicants cooperation in this matter is appreciated.

1. The disclosure is objected to because of the following informalities: Applicant has referred to various application numbers at pages 11 and 15. Applicant needs to update the status of the referred to application numbers and indicate a patent number if in fact the applications have issued. This is especially important when applicant is incorporating by reference older applications as is the case here.

Appropriate correction is required.

2. The amendment filed 3-24-00 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment

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shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The recitation of claims 66,69,74,77, that states the binder (not clear which one, see 112,2<sup>nd</sup> below) is at least one of bicomponent fibers and a wet strength agent. This claim includes the situation where the binder is both the bicomponent fiber and the wet strength agent. This is new matter that has been added to the specification. The examiner could not find support as originally filed for the binder being two things (a fiber and a wet strength agent). The specification only discloses that the layers of the composite each have a binder (not more than one binder).

3. The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

4. The specification is objected to under 37 CFR 1.71 because the specification as originally filed fails to provide support for the claim limitation of claims 66,69,74,77, as is discussed in the objection to the amendment of 3-24-00. The specification is objected to for the same reason.

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5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 66,69,74,77, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 69 is rejected for the same reasons as was set forth in the objection to the specification under 37 CFR 1.71 and the objection to the amendment of 3-24-00.

Applicant is required to cancel the new matter in the reply to this Office Action.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1,6-20,24,25,32,33,62-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1,32,33,62,67,70, there is no antecedent basis for the following: "the first and second strata". How many layers are being claimed here? Earlier in the claim there is a recitation of "first stratum" and "second stratum". It is not clear what the recitation of "the first and second strata" refer to.

With respect to claim 8, what is meant by claiming that the pore size of the first stratum is greater than the second stratum? How can a pore size be larger than the

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entire second stratum? The examiner suggest claiming that the pore size of the first stratum is greater than the pore size of the second stratum.

With respect to claim 13, what hydrophobic fibers are being referred to here? The hydrophobic fibers of the 1<sup>st</sup> or 2<sup>nd</sup> stratum? This is not clear. If applicant is referring to the 2<sup>nd</sup> stratum then this claim would be claiming that the fibers of the 2<sup>nd</sup> stratum are hydrophobic instead of being one of the members of the claimed Markush group. The examiner does not know what fibers are being referred to here.

With respect to claim 15, what natural fibers? None have been previously claimed. There is no antecedent basis for "the natural fibers".

With respect to claims 16,66,69,74,77, what binder is being referred to here? The binder of the 1<sup>st</sup> stratum or the 2<sup>nd</sup> stratum? This is not clear and is very similar to the 112 problem of claim 15.

With respect to claims 17,18, there is no antecedent basis for the following: "the fibrous binding material". None has been previously claimed. What does this refer to?

With respect to claims 24,25, is applicant now reciting that the fibers of the 2<sup>nd</sup> stratum are in fact the hydrophilic fibers of the Markush group of claim 1? The examiner does not know if applicant is now claiming that the fibers of the 2<sup>nd</sup> stratum are hydrophilic or if applicant is just limiting one of the member of the Markush group but where the fibers are still one of the members of the Markush group (and not necessarily hydrophilic fibers). This is not clear to the examiner.

Applicant should take notice that due to the 112 problems noted above, the lack of a prior art rejection on any given claim should not be construed as an indication of

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allowability. The application of prior art may be difficult if not impossible for some claims because of the indefiniteness of the claims.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1,6-9,11,13-15,20,33,63,70,71,74, are rejected under 35 U.S.C. 102(b) as being anticipated by Pieniak (4723954).

With respect to claims 1,6,7,8 (as best understood),18,19,24-26,62,66, Pieniak discloses a 1<sup>st</sup> stratum 32 and 2<sup>nd</sup> stratum 30. The 1<sup>st</sup> stratum has hydrophobic fibers (See Summary) and a binder (see column 3, lines 4-17). The 2<sup>nd</sup> stratum is made from the claimed fibers and does have a binder. The term binder is being interpreted as it has been defined by the specification on page 13. The disclosure of air laying the 2<sup>nd</sup> stratum with compression or vacuum being applied acts to bind the layer together and is therefore considered a binder. The fibers of each stratum are substantially commingled as claimed. See the figures.

With respect to claims 9,11, see column 2, lines 64-66, which satisfies the claimed range.

With respect to claims 13,14, Pieniak discloses natural fibers.

With respect to claim 15, as best understood due to the 112,2<sup>nd</sup> rejection the examiner considers Pieniak to have the claimed limitation.

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With respect to claim 16, the binder of the 1<sup>st</sup> stratum is a fibrous binding material because it binds together fibers (a fibrous material).

With respect to claim 20, Pieniak discloses the claimed limitation. This is because claiming a denier without also claiming the material the fiber is made from means nothing. Denier is a fineness of a fiber based on 1 gram of the fiber drawn to a certain length. From this it is clear that the fineness can only be determined if the material is also claimed.

With respect to claims 33,70,74, Pieniak discloses a 1<sup>st</sup> stratum 32 and 2<sup>nd</sup> stratum 30. The 1<sup>st</sup> stratum has hydrophobic fibers (See Summary) and a binder (see column 3, lines 4-17). The 2<sup>nd</sup> stratum is made from the claimed fibers and does have a binder. The term binder is being interpreted as it has been defined by the specification on page 13. The disclosure of air laying the 2<sup>nd</sup> stratum with compression or vacuum being applied acts to bind the layer together and is therefore considered a binder. The fibers of each stratum are substantially commingled as claimed. See the figures. The limitation of "foam-formed" has been considered but is a product by process limitation and only the end structure of the article will be given patentable weight, not the manner in which the article was made. The resulting end structure is found in Pieniak.

With respect to claims 63,71, see column 2, lines 57-60.

11. Claims 1,6-16,19,20,33,63,70,71,73-75,77, are rejected under 35 U.S.C. 102(b) as being anticipated by Butterworth et al. (4129132).



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With respect to claims 1,6,7,8 (as best understood),18,24,25,62,65-67,69, Butterworth discloses a 1<sup>st</sup> stratum (the first fibrous layer) and a 2<sup>nd</sup> stratum (the 2<sup>nd</sup> fibrous layer). The 1<sup>st</sup> stratum is disclosed as having hydrophobic fibers (see column 6, lines 1-14). The binder of the 1<sup>st</sup> stratum is disclosed in column 5, lines 59-68, column 6, line 62 to column 7, line 1, column 4, lines 34-39, and in column 11, lines 20-26. The 2<sup>nd</sup> stratum made from the claimed fibers. The binder of the 2<sup>nd</sup> stratum is disclosed in column 4, lines 34-39, column 7, lines 3-11, and in column 11, lines 20-26. For the limitation of the substantially commingled fibers see column 3, lines 1-13, column 3, lines 31-38, and column 8, lines 10-18.

With respect to claims 9-12, see column 4, lines 50-53 where the claimed limitations are shown.

With respect to claims 13,14, see column 6, lines 1-14.

With respect to claim 15, as best understood due to the 112,2<sup>nd</sup> rejection the examiner considers Butterworth to have the claimed limitation.

With respect to claim 16, the binder of the 1<sup>st</sup> stratum is a fibrous binding material because it binds together fibers (a fibrous material).

With respect to claim 19, see column 4, lines 45-49.

With respect to claim 20, Butterworth discloses the claimed limitation. This is because claiming a denier without also claiming the material the fiber is made from means nothing. Denier is a fineness of a fiber based on 1 gram of the fiber drawn to a certain length. From this it is clear that the fineness can only be determined if the material is also claimed.

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With respect to claims 33,70,71,73-75,77, Butterworth discloses a 1<sup>st</sup> stratum (the first fibrous layer) and a 2<sup>nd</sup> stratum (the 2<sup>nd</sup> fibrous layer). The 1<sup>st</sup> stratum is disclosed as having hydrophobic fibers (see column 6, lines 1-14). The binder of the 1<sup>st</sup> stratum is disclosed in column 5, lines 59-68, column 6, line 62 to column 7, line 1, column 4, lines 34-39, and in column 11, lines 20-26. The 2<sup>nd</sup> stratum made from the claimed fibers. The binder of the 2<sup>nd</sup> stratum is disclosed in column 4, lines 34-39, column 7, lines 3-11, and in column 11, lines 20-26. For the limitation of the substantially commingled fibers see column 3, lines 1-13, column 3, lines 31-38, and column 8, lines 10-18. The limitation of "foam-formed" has been considered but is a product by process limitation and only the end structure of the article will be given patentable weight, not the manner in which the article was made. The resulting end structure is found in Butterworth.

With respect to claim 63, see column 6, lines 1-14.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 10,12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Pieniak. Pieniak discloses the invention substantially as claimed.

With respect to claims 10,12, Pieniak does not disclose what the density of the 2<sup>nd</sup> stratum is. The 2<sup>nd</sup> stratum of Pieniak does have a density, Pieniak is just silent as to what the value is. The examiner notes that the instant specification does not disclose that the claimed density solves any stated problem or produces any unexpected result so the examiner concludes the limitation of the density to be a matter of design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Pieniak with the claimed density.

15. Claims 32,62-77, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wanek (5294478) in view of Pieniak (4723954).

Wanek discloses a 1<sup>st</sup> stratum (the 1<sup>st</sup> surge layer of Wanek). The 2<sup>nd</sup> stratum is considered to be the absorbent layer of Wanek. See column 4, lines 6-22 for a disclosure of the claimed type of fibers and binder for the 1<sup>st</sup> stratum. See column 7, lines 1-34 for a disclosure of the fibers of the 2<sup>nd</sup> stratum. See column 3, line 61 to column 4, line 5 for the disclosure of the binder of the 2<sup>nd</sup> stratum. Wanek does not disclose that the 1<sup>st</sup> and 2<sup>nd</sup> stratum have the fibers of each layer commingled at the interface as claimed. Pieniak discloses an absorbent article that has two layers bonded

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to together by commingling of fibers. Pieniak discloses that this type of fiber commingling promotes the wicking of fluid into the absorbent structure. It is not stated explicitly by Pieniak but it is recognized in the art that this type of fiber commingling also adds structural integrity to the bonded layers and helps resist delamination of the two layers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to commingle (entangle) the fibers of the 1<sup>st</sup> stratum with the fibers of the 2<sup>nd</sup> stratum of Wanek as claimed so that the layers have more structural integrity as well as providing enhanced wicking of fluids as disclosed by Pieniak.

### ***Double Patenting***

16. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

17. Claims 1-6-20,24-26,62-69 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-23,25-32 of copending Application No. 09/620947. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

18. Claims 33,70,71,73-75,77 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1,26-29,51,52 of copending Application

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No. 09/620950. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

19. Claims 1,13,25,62,63,65,66,67,69 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3,26-29,51,52 of copending

Application No. 09/620953. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

20. Claims 1,62,63,65,66,67,69 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1,26-29,51,52 of copending Application

No. 09/621167. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

21. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

22. Claims 1,6-20,24,25,32,33,62-77 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the pending claims of copending Application No. 09/620953, 09/624263, 09/621167, 09/624262, 09/326213, 09/624081, 09/620947, 09/620950. Although the conflicting

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claims are not identical, they are not patentably distinct from each other because they overlap in scope and a terminal disclaimer is required to maintain common ownership of claims of overlapping scope. Some of the claims simply fail to recite elements of the claims of the above mentioned pending applications. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

DR  
April 13, 2002

  
DENNIS RUHL  
PRIMARY EXAMINER